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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,729	10/11/2001	Hideki Kinugawa	214782US2X	6059

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/973,729		KINUGAWA ET AL.	
	Examiner		Art Unit	
	Dennis Ruhl		3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1,2,4,6,8-12, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for calculating points when the operating time (used time or load ratio) is less than the standard time (standard used time or standard load ratio), the specification does not reasonably provide enablement for calculating points regardless of whether or not the operating time (used time or load ratio) is less than standard time (standard used time or standard load ratio). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. In the event that the operating time is more than the standard time, how are the points calculated? This is not clear because the only equation disclosed in the specification relates to the situation where the operating time is less than the standard time. One of skill in the art would not know how to go about calculating points when the operating time is more than the standard time, which is within the scope of the claims. Because one of skill in the art would have no idea how to go about calculating the points in the situation where the operating time (used time or load ratio) is more than the standard time (standard used time or standard load ratio), the examiner concludes that undue experimentation would be required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,9,11,12, the portion of the claim that reads “calculating a point number for service to every renter on the basis of an evaluation standard preset from said operating information by said information control means” is indefinite. It is not clear what this language means or is attempting to define. What does “point number for service” mean? The examiner is interpreting this to be just the calculation of a point value for purposes of examination. What does it mean to recite that the evaluation standard is preset from the operating information? This is not clear. The portion of the claim that reads “said point number every renter” is also not clear and does not make sense. What is this portion supposed to be reciting?

For claims 3,5,7, what does the language “in proportion to a value obtained by” mean? The examiner is not clear as to what this means. Also, claim 3 is reciting that the evaluation standard is used to calculate a point number only in a case when the operating time (or load ratio, etc.) is less than the standard operating time. This language seems to contradict claim 1, which states that a point number is calculated, with no conditions being set forth. Is the point number being calculated like claim 1 recites, or is it only calculated when the condition set forth in claim 3 occurs? The scope of the claim is not clear.

For claim 6, what is meant by “special specification”? What is the scope of this term? This is not clear.

For claim 8, what is meant by a “stock state” of a construction machine? How can one machine have a stock state? It is not clear as to what this language means.

For claim 11, it is not clear as to how many construction machines are in the scope of this claim. Line 3 recites “one or more construction machines” whereas lines 8-9 recite “said construction machine”. Is there one or more or just one? This is not clear.

For claim 12 the scope of the claim is not clear. This is because applicant has claimed a receiving device “communicable” with information control means. This portion of the claim is not positively reciting the information control means as being part of the claimed terminal. Then later in the claim applicant goes on to recite structure to the information control means. Is the information control means being positively claimed as part of the scope of the claim or is it just recited that the receiving device is “communicable” with the information control means. This is not clear.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1,2,4,6,9,11,12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hideki (EP 0989525A2) in view of the article "Budget Aims for Hole in One With Innovative New Frequent Renter Program Linked to Callaway Golf Company".

For claims 1,2,4,6,9,11,12, Hideki discloses a system and method for the renting of construction machines with special specifications. The individual construction machines have the ability to store information relating to the use of the construction machine (operating time, fuel consumption [claimed as load ratio], etc.). See page 4, line 57 to page 5, line 6. The information control means is considered to be 20, which is a management apparatus that receives the operating information from the construction machines. Not disclosed is that a "point number for service" to every renter is calculated. The examiner interprets this language to be reciting a point number as is used in customer loyalty programs. The Budget article discloses that the Budget vehicle rental company started a customer awards program that awards members with one point for each dollar spent. This is done so that the customer is enticed to do business with Budget and is more or less a marketing tool. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the

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construction machine rental system and method of Hideki with a customer awards program that awards customers points based on the amount of business they do with the construction machine rental company and to present the total number of points to the renters so that they know how many they have earned. The claimed "evaluation standard" is the standard that 1 point is awarded for every dollar spent. That is an evaluation standard to controls how the points are awarded.

8. Claims 1-4,6,7,9,11,12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hideki (EP 0989525A2) in view of the article "Cell phone users can roll minutes over".

For claims 1-4,6,7,9,11,12, Hideki discloses a system and method for the renting of construction machines with special specifications. The individual construction machines have the ability to store information relating to the use of the construction machine (operating time, fuel consumption [claimed as load ratio], etc.). See page 4, line 57 to page 5, line 6. The information control means is considered to be 20, which is a management apparatus that receives the operating information from the construction machines. Not disclosed is that a "point number for service" to every renter is calculated. The cell phone article discloses that for cell phones, it is known to sell customers of the cell phone service a "bucket" of minutes. The user pays for a bulk total of minutes that allows the user to use the phone system (akin to renting a total amount of usage time on the phone system and communication network). If the user does not use all of the time they paid for, the article discloses that the unused time

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should be allowed to “roll over” to another billing period. In view of this article, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Hideki reference so that customers who desire to rent construction machines can purchase “buckets” of usage time for the use of rental machines and in the event the customer does not use their purchased usage time in a given time period, allow them to carry over the unused time. This then results in a calculation of a point number for every renter, which is the amount of time they paid for minus the used time, which equals a point number (unused usage time).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER